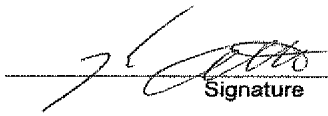


| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) 1046_027 | |
|--|--|--------------------------------------|--|
| | Application Number 10/604,108 | Filed June 26, 2003 | |
| | First Named Inventor Neal A. Downey, et al. | | |
| | Art Unit 2656 | Examiner T. Chen | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number 50,551</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34.</p> <p> Signature Kenneth Altshuler Typed or printed name (303) 449 6444 x1251 Telephone number 12/27/06 Date</p> | | | |
| <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of 1 forms are submitted.</p> | | | |

UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Neal A. Downey; Samuel J. Guleff; Christian C. Curtis
Confirmation No.: 1119
Serial No.: 10/604,108 Art Unit: 2656
Filed: June 26, 2003 Examiner: Tianjie Chen
Customer No.: 44,331
Title: MAGAZINE-BASED DATA CARTRIDGE LIBRARY

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICANT'S REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the Advisory Action mailed on November 24, 2006 ("the Advisory Action"), Applicant trusts that the Panel's objective review will conclude that all the outstanding issues, some being reiterated herein summarily, are not bona fide matters for appeal, but rather are issues that clearly should be resolved in Applicant's favor based upon the record. Please enter the following remarks as Applicant's bases for filing this Pre-Appeal Brief Request for Review.

IT IS CLEAR ERROR THAT THE EXAMINER HAS FAILED TO SUBSTANTIATE ANTICIPATION AND/OR A PRIMA FACIE CASE OF OBVIOUSNESS BOTH BY FAILING TO FIND TRUE CORRESPONDENCE BETWEEN ELEMENTS IN THE PRIOR ART SYSTEMS AND THOSE IN THE CLAIMS AND BY FAILING TO SUBSTANTIATE A REASONABLE MOTIVATION TO COMBINE AND MODIFY THE PRIOR ART REFERENCES

Claims 1, 21-28 and 30-40 stand rejected under 35 U.S.C. § 103(a) as being obvious over 5,818,723 to Dimitri (hereinafter referred to as "Dimitri") in view of U.S. Patent No. 6,324,608 to Papa et al. (hereinafter referred to as "Papa") in view of U.S. Patent No. 5,440,637 to VanFleet (hereinafter referred to as "VanFleet") and in view of U.S. Patent No. 6,532,652 to Nagai (hereinafter referred to as "Nagai"). Claim 29 stands rejected under 35 U.S.C. § 103(a) as being obvious over Dimitri in view of Papa in view of VanFleet in view of Nagai and further in view of U.S. Patent No. 6,545,865 to Albrecht et al. (hereinafter referred

to as “Albrecht”).

The Examiner has failed to properly construe the references in relation to independent claims 1, 34 and 40. In both the Final Rejection of 09/25/2006 and the Advisory Action of 12/05/2006 the Examiner has maintained that Nagai shows in FIG. 3 and FIG. 5 “that the first tap is located between the first and second ends of Nagai’s FFC”. The Examiner’s interpretation of Nagai is artificial and contrived. For example, one could argue that a connector at the end of a wire is really not in contact at the infinitesimal limit of the wire’s end, but rather is spaced at some distance, possibly atoms, away from the end. As is clearly shown by FIG. 5 and also as is written in Nagai’s disclosure (column 4, lines 13-19), the taps and connectors 17 are essentially at the end of the wires.

“Then as shown in FIG. 3, slots 14A are formed in the FFC 11 between any two conductive strips 12 at a predetermined distance from the end of the of the FFC 11. Accordingly, a connection area A along the end of the FFC 11 and a separated area B located next to the connection area are defined. In addition to the slots 14A, cutouts 15A are formed along the longitudinal edges of the FFC 11 and in the separated area B.”

And, also from the descriptions of the figures:

“FIG. 5 illustrates the step of forming slits in the FFC from the end of the FFC so as to communicate with the associated slots”

Furthermore, the Examiner has failed to carry his burden of making a *prima facie* showing that one of ordinary skill in the art would have been motivated to combine the relevant disclosures of Dimitri, VanFleet, Papa and Nagai. A *prima facie* case of obviousness must be established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modifications. See *In re Lintnre*, 9 F. 2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). The Examiner’s fragmented rationale (over pages 3 and 4 with additional arguments in between) for combining all four references against the independent claims in the Final Rejection of 09/25/2006 would not achieve the solution the problem that Applicant’s claimed invention achieves. Applicant’s claimed invention is directed to providing power to a plurality of drives for use in drive bays (see claim 39) disposed along the length of a flat common conductor and not simply at one or both ends of the conductor. This is illustrated in the recitation of claim 40, “a plurality of taps

located between said two ends wherein said drives are electrically connected to said flat power conductor via said taps.” By combining the references, even with thte contorted hindsight reconstruction urged by the Examiner, one skilled in the art would not have been able to attain Applicant’s claimed invention. The Examiner’s rationale is hardly the “thorough and searching” factual inquiry required to support the Examiner’s combination of the teachings of the references, especially since Dimitri, VanFleet, Papa and Nagai are at least directed entirely to solving different problems (i.e. an audio play-back station (VanFleet), a method for manufacturing wire harnesses (Nagai), removal and replacing interface modules (Papa)) in relation to their disclosed systems. See *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).

With regard to the rejections of the dependent claims, their patentability stands with the patentability of their associated independent claims.

Applicant again submits that the Examiner’s combination of Dimitri in view of VanFleet in view of Papa in view of Nagai and in view of Albrecht would not have rendered the Applicant’s claimed invention obvious because certain features of Applicant’s claimed invention are not present in the references, certain purportedly corresponding elements are inapposite, and there is no reasonable motivation to combine the teachings of the references because they are directed to solving very different problems. For at least the forgoing reasons, the Examiner’s rejections cannot stand and the application should be allowed to issue.

Applicant requests that the Pre-Appeal Board allow the pending claims.

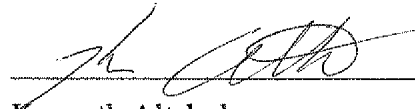
* * *

Authorization To Charge Necessary Fees

The Commissioner is hereby authorized to charge any necessary fees associated with this submission, or credit any overpayment, to Deposit Account No. 50-3010.

Respectfully submitted,

Dated: 12/27/06



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